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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,128	06/07/2007	Reiner Fischer	2400.0720000/VLC	7332
26111 7590 03/15/2010 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
BUCKLEY, AUDREA				
ART UNIT		PAPER NUMBER		
1611				
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03/15/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/591,128

**Applicant(s)**

FISCHER ET AL.

**Examiner**

AUDREA J. BUCKLEY

**Art Unit**

1611

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 9 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date 12/17/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of the Claims***

Acknowledgement is made of Applicants' claim amendments and remarks/arguments filed 12/17/2009. Claim 7 was canceled. Applicant has requested rejoinder of claims 6, 10, and 11; however, the restriction requirement of 6/16/2009 is maintained in view of the obviousness rejections presented below.

Claims 1-5, 8, 9, and 12 are pending and under consideration in the instant Office action.

***Withdrawn Claim Rejections***

The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Turburg et al. is withdrawn in light of Applicants' amendments to the claims filed 12/17/2009.

The rejection of claims 2-5, 9, and 12 under 35 U.S.C. 103(a) as being unpatentable over Turberg et al. is withdrawn in light of Applicants' amendments to the claims filed 12/17/2009.

The rejection of claims 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over Turberg et al. and further in view of Hoffarth is withdrawn in light of Applicants' amendments to the claims filed 12/17/2009.

***New Grounds of Rejection as Necessitated by Amendments***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-5, 8, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turberg et al. (US 2005/0214336 A1, filed internationally as WO 2003/086075, published 10/23/2003) in view of Hoffarth (US 5,705,476).**

The formulation comprising a compound of formula (I') as instantly claimed was disclosed by Turberg et al. (see page 2, column 1, [0005]-[0030]), vegetable oils (page

8, column 2, [0180]; page 9, column 1, [0195]), surfactants including nonionic ones (page 9, column 1, [0200]), and optional additives including antioxidants and colorants (page 8, column 2, [0187]-[0190]) are included. For emphasis, the compound of formula (I') previously was taught wherein the prior disclosure included both the core structure and the exact, specific substituents as instantly claimed (see page 2, column 1, [0005]-[0030]). For example and as to claim 5, the identities of "V" and "A and B together" previously were defined by Turberg et al. (see page 1, column 2, [0015]-[0016]). As to claim 9, Turberg et al. teach an active agent presence of preferably 1.0-40% by weight (see page 8, column 1, [0170]), where the instant claim limits this component to an amount between 5 and 30% by weight. As to claim 12, Turberg et al. teach adjuvant components serving as extenders and/or surface-active reagents (see page 8, column 1, [0173]-[0175]).

As to claims 1 and 8, Turberg et al. do not teach alkanol alkoxylate agents as components in the parasite control composition.

However, Hoffarth discloses low-foaming wetting agents (wetting agents = penetrants = dispersing agents) consisting of various alkoxylated alcohol mixtures for applications such as crop protection agents, for example (see abstract, in particular; see also, column 1, lines 10-16). Further, Hoffarth teaches various alkoxylate species such as formula (Ia), illustrated in column 8, claim 1, a species which names the alkanol alkoxylate of formula (Id) in instant claims 1 and 8.

One of ordinary skill in the art at the time the invention was made would have been motivated to look to the teachings of Hoffarth in order to determine an effective

wetting agent or penetrant identity for the agricultural formulation of Turberg et al. which suggests that these auxiliaries may be added (see [0205]). One would have been motivated to do so since Hoffarth teaches improved wetting action (penetration) upon implementation of the disclosed alkoxyated alcohol mixtures. A skilled artisan reasonably would have expected continued success in the combination since both disclosures are in the field of agricultural applications where optimal pest control is desirable to maximize the agricultural yields.

As to claims 9 and 12, Turberg et al. does not disclose the exact formulation component and ranges as instantly recited.

As to claim 9, the skilled artisan would have expected these overlapping ranges to have had similar results, and the skilled artisan would have been motivated to optimize the active agent presence as is routine in the art (see MPEP 2144.05). As to claim 12, where each of these components was disclosed in Turberg et al., the skilled artisan would have expected continued success for applying these formulation components, particularly, the phenylketonol derivatives, for the systemic and nonsystemic control of animals. Additionally, the skilled artisan would have found the adjustment of formulation components based on the disclosure of Turberg et al. (i.e., variable derivatives of the core molecule of Formula (I') and concentration of formula components) to have been routine optimization procedure.

***Response to Arguments***

Applicants' arguments presented 12/17/2009 have been fully considered but are moot in light of amendment. As noted above, all rejections previously presented and not re-iterated herein are withdrawn. Applicants' positions against cited references are summarized and responded to as follows.

Applicant traverses the rejections relying on Turberg since Turberg fails to disclose the particular penetrant of formula (Id), an alkanol alkoxylate species, as recited in amended claim 1. Applicant additionally takes the position that Turberg's compositions are not used for an "analogous function" since Turberg teaches the control of parasites in animals and not the control of insects in plants. In response, Applicants' position has been fully considered but is moot in light of amendment.

Applicant traverses the rejection of claim 8 under 35 U.S.C. 103(a) as being unpatentable over Turberg in view of Hoffarth, stating that Hoffarth does not cure the deficiency of Turberg. Applicant states that Hoffarth utilizes alkoxylated alcohols as low-foaming wetting agents (i.e., for formulating crop protection agents) rather than as penetration enhancers. In response, the Examiner points out that a wetting agent is a dispersant, both of which are penetration enhancers.

Applicant argues that the skilled artisan would not have combined Turberg and Hoffarth references since these references are directed respectively to animal applications and crop protection agents; Applicant takes the position that the Examiner used improper hindsight analysis to combine these teachings and that, therefore, a prima facie case of obviousness has not been presented. The Examiner's position

remains that both Turberg and Hoffarty are directed to agricultural formulations for pest control, and that it is within the skill of the artisan to implement the penetrants (wetting agents) as taught by Hoffarty upon Turberg's suggestion to do so.

Finally, Applicant states that the instant disclosure utilizing the alkoxylated alcohol agent provides a better crop tolerance as well as higher insecticidal efficacies against particular species when compared with other examples disclosed in the specification. In reply, it is the Examiner's position that Applicants' evidence of nonobviousness is insufficient to rebut the evidence of prima facie obviousness since the properties associated with the dispersant have not been shown to have a significance materially improving the overall pesticidal efficacy, attributed to the active agents rather than the additives, of the suspension concentrate.

### ***Conclusion***

No claims are found allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AUDREA J. BUCKLEY whose telephone number is (571)270-1336. The examiner can normally be reached on Monday-Thursday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AJB/

/Sharmila Gollamudi Landau/  
Supervisory Patent Examiner, Art Unit 1611